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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,950	08/01/2003	Selvakumar Natesan	U 014735-7	4979

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Ladas & Parry
26 West 61st Street
New York, NY 10023

EXAMINER

SHAMEEM, GOLAM M

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,950

Applicant(s)

NATESAN ET AL

Examiner

Golam M. M. Shameem, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 31-60 is/are pending in the application.
- 4a) Of the above claim(s) 8-20, 32-34, 36-40, 47, 48 and 55-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 31, 35, 41-46 and 49-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-20 and 31-60 are currently pending in the application. Claims 21-30 were canceled previously

Receipt is acknowledged of amendment / response filed on May 27, 2005 and that has been entered. Claims 8-20, 32-34, 36-40, 47-48 and 55-60 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

Response to Arguments

Applicant's arguments [to withdrawal of the rejection of claims 1-7, 31, 35, 41-46 and 49-54 under the judicially created doctrine of obviousness-type double patenting over claims 1-87 of co-pending Application No. 10/613,414] have been fully considered and found unpersuasive due to the following reasons:

Claims 1-7, 31, 35, 41-46 and 49-54 are rejected under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over co-pending Application No. 10/613,414 of record and the rejection has been maintained for the reasons given in the last office action mailed on 01/24/2005. Applicant's arguments have been fully considered but are not deemed persuasive because Applicants' arguments unsupported by objective and competent factual evidence are entitled to little weight. *In re Greenfield* 197 USPQ 227. *In re Lindner* 173 USPQ 356. Applicant alleges, "In claim 1 of this application Z is defined as NR^b and the definition of R^b differs between the claims of the two applications. The definition of R¹ differs between the two inventions" (Response, page 38). This assessment is speculation on Applicant's behalf because US patent application 10/613,414 broadly teaches the generic compounds and

Art Unit: 1626

compositions having similar variable substitutions, such as R^1 is NHR^4 , where R^4 represents thio(C_1 - C_{10})acyl among others, Z represents NR^b where R^b represents hydrogen, alkyl, aryl, aralkyl, aryloxy etc (see claim 1) which are within the boundaries of the instantly claimed compounds and compositions. Therefore, in the instant case, one skilled in the chemical art would be motivated to choose to replace variable substitutions (such as R^1 is NHR^4 and Z is NR^b or any other similar obvious variables) in core heterocyclic ring in view of the known teaching of the art. The claimed compounds are so closely related structurally to the homologous and /or analogous compounds of the reference as to be structurally obvious therefore in the absence of any unobviousness or unexpected properties. Since the core oxazole ring of compound of formula (I) is not novel and the novelty (if there is any) belongs to the selection of different variable substitutions, a great caution should be exercised to determine the patentability of the claimed invention. Therefore, in the absence of objective evidence showing an unexpected result, the obviousness-type double patenting rejection is deemed to be proper and hence, this rejection must be maintained.

Therefore, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 7:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone number for this Group is (571) 273-8300. When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

Golam M M Shameem, Ph.D.
Primary Examiner
Art Unit 1626
Technology Center 1600

A handwritten signature in black ink, appearing to read 'G. M. Shameem', with a stylized, cursive script.

GOLAM M. M. SHAMEEM, PH.D
PRIMARY EXAMINER

June 10, 2005